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(to be used for all correspondence after initial filing)

Application Number	09/837,094
Filing Date	April 18, 2001
First Named Inventor	James M. Sheppard JR.
Art Unit	1771
Examiner Name	Jenna Leigh Befumo
Attorney Docket Number	3129

Total Number of Pages in This Submission

30

**ENCLOSURES (Check all that apply)**

<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance communication to Technology Center (TC)
<input checked="" type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input checked="" type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
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**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm or Individual name	DOUGHERTY   CLEMENTS Gregory N. Clements
Signature	
Date	May 15, 2006

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Signature		Date	May 15, 2006

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# FEE TRANSMITTAL

## For FY 2005

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ ) 250.00

### Complete if Known

Application Number	09/837,094
Filing Date	April 18, 2001
First Named Inventor	James M. Sheppard JR.
Examiner Name	Jenna Leigh Befumo
Art Unit	1771
Attorney Docket No.	3129

### METHOD OF PAYMENT (check all that apply)

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#### 1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	<u>Small Entity</u> Fee (\$)	Fee (\$)	<u>Small Entity</u> Fee (\$)	Fee (\$)	<u>Small Entity</u> Fee (\$)	
Utility	300	150	500	250	200	100	_____
Design	200	100	100	50	130	65	_____
Plant	200	100	300	150	160	80	_____
Reissue	300	150	500	250	600	300	_____
Provisional	200	100	0	0	0	0	_____

#### 2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	<u>Small Entity</u> Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180
<u>Total Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>
- 20 or HP = _____ x _____ = _____		
HP = highest number of total claims paid for, if greater than 20.		
<u>Indep. Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>
- 3 or HP = _____ x _____ = _____		
HP = highest number of independent claims paid for, if greater than 3.		

#### 3. APPLICATION SIZE FEE


If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

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#### SUBMITTED BY

Signature 	Registration No. 30,713 (Attorney/Agent)	Telephone 704/366-6642
Name (Print/Type) Gregory N. Clements		Date May 15, 2006

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Application No.: - 09/837,094

Filed: - April 18, 2001

Applicant: - James M. Sheppard JR.


Title: - JACQUARD OR DOBBY WOVEN TEXTILE WITH  
GRAPHIC IMPRESSION AND A METHOD OF  
MAKING SAME

Examiner: - Befumo, Jenna Leigh

Art Unit: - 1771

Attorney Docket No.: - 3129

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Nancy L. Burns



IN THE UNITED STATES  
PATENT AND TRADEMARK OFFICE BEFORE THE  
BOARD OF  
PATENT APPEALS AND INTERFERENCES

In re Application of:

Sheppard

Serial No.: 09/837,094

Filed: April 18, 2001

For: JACQUARD OR DOBBY  
WOVEN TEXTILE WITH  
GRAPHIC IMPRESSION AND  
A METHOD OF MAKING THE  
SAME

Group Art Unit: 1771

Examiner: Befumo, Jenna-Leigh

Appeal No.:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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BRIEF OF APPELLANTS

This is an appeal from the final rejection of the Examiner dated December 16, 2005, rejecting Claims 21, 22, and 24-27, all claims currently pending in the case. The Appellant files this Appeal under 37 C.F.R. § 41.31(a), having had all claims twice rejected. The requisite fee set forth in 37 C.F.R. § 41.20(b) was presented on April 19, 2005.

*REAL PARTY IN INTEREST (37 C.F.R. § 41.37(c)(1)(i))*

Inventor James M. Sheppard has assigned all his rights and interests in the current invention to Devant Ltd., a North Carolina Corporation. As such, Devant Ltd. is the real party in interest in this case. Mr. Sheppard is the President of Devant Ltd.

*RELATED APPEALS AND INTERFERENCES (37 C.F.R. § 41.37(c)(1)(ii))*

Appellant has previously appealed related Application Serial No. 09/747,529, entitled JACQUARD WOVEN TEXTILE WITH GRAPHIC IMPRESSION AND A METHOD OF MAKING THE SAME, having a filing date of December 22, 2000, to the board in an Appeal Brief filed on April 23, 2003. In a decision dated July 29, 2004, the Board reversed the Examiner's previous rejection of record. A copy of the Board's decision is included in the Related Proceedings Appendix. Prosecution has been reopened. A Notice of Appeal was filed on April 1, 2006. Appellant's Appeal brief in that case was filed on the same date as this Brief. The claims in this related case are similar to those under appeal herein and are rejected under 35 U.S.C. 103(a) on the basis of the references used by the Examiner here.

An appeal has been filed for related Application Serial No. 10/314,794, entitled A METHOD OF MAKING JACQUARD WOVEN TEXTILE WITH GRAPHIC IMPRESSION, having a filing date of February 19, 2003. A Notice of Appeal was filed on April 1, 2006. Appellant's Appeal brief in that case was filed on the same date as this Brief.

The Board is asked to consider all three appeals as a group as the subject matter and rejections of each are related.

*STATUS OF CLAIMS (37 C.F.R. § 41.37(c)(1)(iii))*

The application was filed on April 18, 2001, and is a continuation-in-part of U.S. Serial No. 09/747,529, which itself claimed priority under 37 C.F.R. § 1.78(a)(4) of U.S. Provisional Application No. 60/173,275 filed on December 28, 1999. This application was originally filed with 20 claims of which two (2) were independent claims (Claims 1, and 16).

The Examiner issued a restriction requirement, and an election was made with traverse to prosecute the invention of claims 1-15. All of the claims 1-15 were rejected in the Examiner's first Office Action of October 4, 2002. In response, the Appellant cancelled claims 1-15 in favor of new claims 21-28. Claim 21 was the only independent claim added.

In the subsequent Office Action of April 22, 2003, which was made final, the Examiner rejected all claims 21-28.

An Amendment After Final Rejection was filed on July 22, 2003.

A Request for Continued Examination was filed on September 22, 2003, as well as a Preliminary Amendment, amending independent claim 21, and canceling dependent claim 28.

In the Office Action dated February 18, 2004, the Examiner rejected claims 21-27. A response was filed on May 18, 2004, amending independent claim 21.

In the subsequent Office Action of August 11, 2004, which was made final, the Examiner again rejected all claims 21-27.

On November 24, 2004, the Appellant filed a Notice of Appeal to the Board of Patent Appeals and Interferences, followed by an Appeal Brief on December 23, 2004. An amended Appeal Brief was filed on April 19, 2005.

On July 14, 2005, the Examiner reopened prosecution, issuing a new Office Action and applying new references, rejecting all Claims 21-27. In response, the Appellant amended Claim 21, and cancelled Claim 23.

In the subsequent Office Action of December 16, 2005, which was made final, the Examiner rejected all claims 21, 22, and 24-27.

The status of the claims is as set out in Examiner's Final Rejection dated December 16, 2005 and is as follows:

Allowed claims—none

Claims objected to—none

Claims rejected—21, 22, and 24-27.

*STATUS OF AMENDMENTS (37 C.F.R. § 41.37(c)(1)(iv))*

The Examiner issued a final Office Action on December 16, 2005. The claims being more than twice rejected, Appellant has chosen to directly appeal the Office Action under 37 C.F.R. § 41.31(a).

*SUMMARY OF CLAIMED SUBJECT MATTER (37 C.F.R. § 41.37(c)(1)(v))*

In the weaving of terry toweling, three series of yarns are employed: (a) pile warp which produces the loops for the pile surface (b) ground warp from which the pile warp projects and (c) weft which binds the two warps together.

Pile warp that is not utilized on the front pattern surface can be woven into terry loops on the reverse side of the textile, woven into the ground warp and weft fibers to create a non-looped, flat weave on the reverse side, or allowed to “float” as unwoven fibers along the backside. This limits the utility for these types of articles, since many designs and logos cannot be adequately reproduced within the confines of the dobby weave.

Printing processes on dobby fabrics have been limited to preprinting the warp filaments with an elongated vertical pattern such that when woven, an article with more than two colors can be achieved. This process requires elaborate computer controlled printing onto the filaments, and very precise monitoring of the weaving process. Printing a pattern post-weave on an article has been employed in dobby situations, but this results in an article that is largely limited to a single color on the nonprinted side of the article. Printing on the reverse side of the dobby article is largely prohibited due to the likelihood that the separately printed images on opposite sides of the article will bleed through the article and disfigure the images on both printed sides. Post printing also has the undesirable side effect of decreasing the absorbency of the towel.

Appellant has recognized the deficiencies of both the weaving process and the traditional printing process and has created the novel “Edge® Towel,” an embodiment of Claim 21. Claim 21 uses dobby weaving to create a towel having central light colored area, surrounded by a dark border. The reverse side of the towel is a dark colored central area surrounded by a light colored border. A design can be printed in the light colored central area of the first side. The dark colored border surrounding the light central area is capable of masking any printed pattern that might overlap onto the border from the central area. This eliminates the need for precise alignment and monitoring that is mandatory in the preprinted filament process. Likewise, the dark central area on the reverse side of the article is capable of masking any potential bleed through of the printed design on the light colored central area of side one. This allows the printed image to be



applied so as to result in a graphic that is more intensely colored than woven articles that are limited to a single front and rear color.<sup>1</sup>

*GROUND OF REJECTION TO BE REVIEWED ON APPEAL*  
*(37 C.F.R. § 41.37(c)(1)(vi))*

The Examiner has rejected Claims 21, 22, and 24-27 under 35 U.S.C. §103(a) as being unpatentable over Stark (U.S. Pat. No. 3,669,818) in view of Parker et al. (1,925,459), and in further view of Sherrill et al. (U.S. Pat. No. 3,721,273). The Examiner has also provisionally rejected claims 21, 22, and 24-27 under the judicially created doctrine of obviousness-type double patenting over the claims of copending Application No. 09/747,529. The issues to be decided in this appeal are the following:

1. It is the Examiner's position that Stark discloses a pile fabric having a patterned surface and a design superimposed on the patterned surface for use in carpets, towels, and upholstery (abstract) wherein various patterns can be woven into or printed on the textile.<sup>2</sup> Further, the Examiner states that Parker<sup>3</sup> discloses a patterned fabric made up of two different color pile yarns using a first color yarn to form the background of the design and a second color to form the image of the design on the first side of the fabric, while the second side of the fabric is the reverse with the first color forming the image and the second color forming the background. The different colored yarns can be used to form stripes or other designs.<sup>4</sup> From this, the Examiner concludes that it would have been obvious to one having ordinary skill in the art to use a pile fabric having a first image on the first side and a reverse image on the second side, as disclosed by Parker et al. as the patterned pile fabric in the printed pile fabric disclosed by Stark since Parker et al. discloses a woven patterned pile fabric and Stark discloses that a printed design can be

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<sup>1</sup> U.S. Pat. App. No. 09/837,904 as filed, page 9, paragraph 1.

<sup>2</sup> U.S. Pat. App. No. 09/837,094 Non-Final Office Action dated 7/14/2005, page 3, numbered paragraph 8.

<sup>3</sup> While the Examiner has referred to Stark, each of the line numbers cited clearly refers to the Parker reference. Therefore, the Appellant concludes that the Examiner's statement actually refers to the Parker reference.

<sup>4</sup> U.S. Pat. App. No. 09/837,094 Non-Final Office Action dated 7/14/2005, page 4, paragraph 2.

combined with a patterned pile fabric of any construction to produce a visually appealing finished product. Further, it is the Examiner's position that Sherrill et al. discloses a border region surrounding a center area with a design or graphic, is known to those in the art. The Examiner concludes that it would have been obvious to one of ordinary skill in the art to create towels with the design structure as shown in Sherrill et al., by combining woven patterns with printed patterns as taught in Stark and Parker et al., which teaches creating towels with different colored sections combined with printed patterns to produce a desired finished product.<sup>5</sup>

2. The Examiner has also provisionally rejected claims 21, 22, and 24-27 under the judicially created doctrine of obviousness-type double patenting over the claims of copending Application No. 09/747,529.

*ARGUMENT (37 C.F.R. § 41.37(c)(1)(vii))*

Issue 1—The rejection of Claims 21, 22, and 24-27 under 35 U.S.C. 103(a) as being unpatentable over Stark (U.S. Pat. No. 3,669,818) in view of Parker et al. (U.S. Pat. No. 1,925,459) and Sherrill et al. (U.S. Pat. No. 3,721,273).

*Issue 1a. CLAIM 21 (37 C.F.R. § 41.37(c)(1)(vii) subheading)*

Stark discloses a printed textile fabric having a woven terry design consisting of areas of high, low, and no piles wherein a different printed pattern is superimposed on the textile, out of register with the woven pattern. Stark discloses that it is desirable to produce "new and aesthetically attractive products"<sup>6</sup>

Parker et al. teach a method of weaving a double faced terry article where terry loops can be on either or both sides of the woven article. Contrasting warp threads, i.e., those that would appear on the reverse side of the article, are allowed to "float." After the

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<sup>5</sup> U.S. Pat. App. No. 09/837,094 Non-Final Office Action dated 7/14/2005, page 8, paragraph 2-3

<sup>6</sup> U.S. Pat. No. 3,669,818 Col. 1, lines 24-25; lines 50-57.

textile is complete, the floating warp threads are cut away. As pointed out by the Examiner, Parker discloses that it is known to use two contrasting colors to weave terry warp. A pattern mechanism could then produce terry loops of one color on the face of the textile, and simultaneously loops of the contrasting color on the back of the terry fabric. The warp threads can then be woven into the ground threads at the ends of the textile.<sup>7</sup>

The Examiner admits that neither Stark nor Parker teach “the specific features of a towel having borders at each edge and a central area where the printing is applied.”<sup>8</sup> The Examiner instead states that “both Stark and Parker acknowledge that various woven and printed designs are known and can be combined together to form any desired visual appearance.”<sup>9</sup>

Sherrill et al. discloses a terry towel having one face cotton terry, and the opposite face rayon terry. As can be seen in the Figures of Sherrill, the first side (Fig. 1) has printed thereon a central design, and an outer region having additional printed designs thereon. The second side (Fig. 2) is entirely of cotton terry without any designs. The Examiner cites Sherrill et al. as evidence that the “design claimed by the Appellant, a border region surrounding a center area with a design or graphic, is known to those in the art.”<sup>10</sup>

Claim 21 is a product-by-process claim that is directed to a towel woven on a Dobby loom using at least two different colors of yarn. Stark does not disclose a specific loom, but discloses that “yarns of different colors may be employed to produce various parts of sections of the patterns....”<sup>11</sup>

Claim 21 calls for a border having a first darker color that is woven adjacent each edge on one side of the towel. Neither Stark, nor Parker, nor Sherrill has this feature. The Examiner admits such, but claims that such features are merely obvious design

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<sup>7</sup> U.S. Pat. No. 1,925,459 Col. 2, lines 66-87.

<sup>8</sup> U.S. Pat. App. No. 09/837,094 Non-Final Office Action dated 7/14/2005, page 6, paragraph 1.

<sup>9</sup> Id.

<sup>10</sup> Id., at page 8, paragraph 2.

<sup>11</sup> U.S. Pat. No. 3,669,818, Col. 1, lines 40-42.

choices. The Sherrill towel is woven such that the first side is entirely rayon terry, while the second side is entirely cotton terry. Therefore, the border of Sherrill as shown in Figure 1 is defined by a printed pattern (reference number 25). A printed border belies the Appellant's invention as set forth in Claim 21, which requires a woven border for proper masking overlap onto the borders on one side, and potential bleed through to the other side.<sup>12</sup>

Claim 21 continues by stating that a border having a second color is adjacent each edge of the towel on its other side. Again, neither Stark nor Parker has this feature. The Examiner admits such, but claims that such features are merely obvious design choices. Sherrill et al. teach that the reverse side, as seen in Figure 2, is entirely of plain cotton terry. The Sherrill et al. towel is specifically manufactured so that the rayon terry piles are entirely on one side of the towel and the cotton terry piles are entirely on the other side.<sup>13</sup> Sherrill et al. teach printing on the rayon fibers only, since they have an increased absorption for certain dyes, as is well known in the art. The printed pattern would therefore appear only on one side, the rayon side, of the towel. The reverse side of the towel, the cotton side, would not have the alternate color pattern as required by Claim 21.

Claim 21 continues by stating that the towel has a central area within the borders on both sides of the towel. While there is a central area in any two-dimensional product, this central area claimed in Claim 21 must be within the borders. The lack of borders by both Stark and Parker makes the location of the central area on the towel unclear to those skilled in the art. The Sherrill et al. towel has a central area on only one side of the towel.

Claim 21 continues by stating that the central area on one side is in a first color, while the central area on the other side is in a second color. While the combination of Stark and Parker teach that different colors can be used on opposite sides of the towel, there is no teaching that the color on a towel is such that the central area on a first side and the borders on the second side are of one color, while the central area of the second

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<sup>12</sup> U.S. Pat. App. No. 09/837,094 as filed, Page 8, paragraph 2, and page 9, final paragraph.

<sup>13</sup> U.S. Pat. No. 3,721,273, col. 2, lines 52-59.

side and the borders of the first side are of a second color. Sherrill teach that the color on a towel is such that the central area on a first side and the borders on the second side are of one color, while the central area of the second side and the borders of the first side are of a second color. This is how the dobby loom is set up to make the towel of Claim 21.

Claim 21 calls for the shearing and blooming of said one side. Stark and Parker are silent as to this. Sherrill et al. disclose cutting and spreading the rayon terry loops.<sup>14</sup>

Claim 21 calls for forming a graphic impression in the central area on one of the sides. Neither Stark nor Parker forms a graphic impression in the central area of a woven product. While Stark does utilize a graphic impression, there is no defined central area for it to be formed within. Figure 1 of Sherrill et al. discloses this.

Utilizing the structure in claim 21 results in a towel having a specific defined structure. This towel is formed by dobby weaving to create an article with a central light colored area, surrounded by a dark border. The reverse side of the article is a dark colored central area surrounded by a light colored border. A design can be printed in the light colored central area of the first side. The dark colored border surrounding the light central area is capable of masking any pattern that might overlap onto the border from the central area. This eliminates the need for precise alignment and monitoring that is mandatory in other weaving and printing processes. Likewise, the dark central area on the reverse side of the towel is capable of masking any potential bleed through of the design on the light colored central area of side one. This allows the image to be applied so as to result in a graphic that is more intensely colored than towels that are limited to a single front and rear color. This structure is present in claim 21.

Finally, Claim 21 requires that “said border on said one side is capable of masking said graphic impression that may overlap onto said border from said ventral area on said one side, eliminating the need for precise alignment of said graphic impression within said central area of said one side” and that “said central are on said other side is

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<sup>14</sup> U.S. Pat. No. 3,721,273, Col. 3, lines 61-62.

capable of masking any potential bleed through of said graphic impression from said central area on said one side. Neither Parker, nor Stark, nor Sherrill discloses this feature.

The Examiner admits that the combination of Stark nor Parker lacks nearly all of the limitations set forth in Claim 21, however the Examiner concludes that such features are of “no patentable weight” and merely “design choices.”<sup>15</sup> The Examiner’s dismissal of the functional language of Claim 21 as being of “no patentable weight” and “design choice” is improper. Claim 21 requires that the “said one side” is capable of masking graphic impression that may overlap onto the border from the central area on said one side and that the central area on “said second side” is capable of masking any potential bleed through of a graphic impression from the central area of the said one side. Appellant is not claiming all towels having the stated structure of, *inter alia*, the “said border on said one side” and the “central area of said one side.” Rather the claims are limited to the subset of towels that have the structure that will result in the claimed functions of (1) masking graphic impressions that may overlap onto the border from the central area on the “said one side” and (2) masking any potential bleed through of the graphic impression from the central area of the “said one side.” These two statements of function impose structure on the claimed towel, *i.e.*, the towel of Claim 21 must have the structure necessary to perform the two stated functions.

The court’s opinion in *In re Stencel*<sup>16</sup> is instructive here as the court stated:

As a matter of claim draftsmanship, appellant is not barred from describing the driver in terms of the structure imposed upon it by the collar having plastically deformable lobes. The framework -- the teachings of the prior art -- against which patentability is measured is not all drivers broadly, but drivers suitable for use in combination with this collar, for the claims themselves are so limited.

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<sup>15</sup> U.S. Pat. App. No. No09/837,094 Non-Final Office Action dated 7/14/2005, page 6, paragraph 1 though page 68 paragraph 1.

<sup>16</sup> *In re Stencel*, 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987).

The court concluded that “Stencel is not inhibited from claiming his driver, limited by the statement of its purpose, and further defined by the remaining clauses of the claims at issue, when there is no suggestion in the prior art of a driver having the claimed structure and purpose.”<sup>17</sup> In similar manner Appellant is claiming his inventive towel in part by stating the functional properties of two portions of the towel’s overall structure. It is entirely proper for Appellant to claim his towel in this manner and equally improper for the Examiner to dismiss these limitations as having “no patentable weight.”

The Examiner is also in error in dismissing the combination of towel structure and print color and pattern set forth in Claim 21 as a matter of design choice.<sup>18</sup> The issue of “design choice” was considered by the court in *In re Kuhle*.<sup>19</sup> In that case, the court held that a claim limitation was a matter of design choice because it solved “no stated problem.”<sup>20</sup> Contrary to the situation in *Kuhle*, the facts in this case establish that the claimed towel structure and print color and pattern do solve stated problems.

First, as set forth at page 8 of the present specification, constructing the towel with the borders and central areas having the claimed lighter and darker structure allows for the graphic impression printed on the central portion of the towel to overlap or be overprinted onto the border portions since any overlap/overprint will be masked by the borders.<sup>21</sup> Second, as stated at page 9 of the present specification, a towel having the claimed lighter and darker structure for the central portions and borders allows the graphic impression imprinted on the first side to have intense and varied colors as any bleed through will be masked by the darker central portion of the second side.<sup>22</sup> Thus, the problems of having to size the graphic impression to precisely fit within the border area or take measures to prevent the graphic impression from overlapping or being overprinted onto the borders of the towel are rectified. In addition, the towel of claim 21

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<sup>17</sup> *Stencel*, 828 F.2d 751 at 755, 4 USPQ2d at 1075.

<sup>18</sup> U.S. Pat. App. No. 09/837,094 Office Action of December 16, 2005, page 3.

<sup>19</sup> *In re Kuhle*, 526 F.2d 553; 188 USPQ 7 (CCPA 1975).

<sup>20</sup> *Kuhle*, 526 F. 2d at 555, 188 USPQ at 9.

<sup>21</sup> U.S. Pat. App. No. 09/837,094 as filed, page 8, paragraph 3; Page 9, paragraph 2.

<sup>22</sup> *Id.*, at page 9, paragraph 2; and at page 8, paragraph 2.

solves the problems of having to design the graphic impression without using colors that would bleed through the towel.

When the limitations of Claim 21 are properly construed, it is seen that Stark '818, Parker et al. '459 and Sherrill et al. '273 do not individually or together teach or suggest the subject matter of this claim. "It is well-established that before a conclusion of obviousness may be made based on a combination of references, there must have been a reason, suggestion, or motivation to lead an inventor to combine those references."<sup>23</sup> As stated in *In re Kotzab*,

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See [In re] *Dembiczak*, 175 F.3d 994 at 999, 50 U.S.P.Q.2D [1614] at 1617 [Fed. Cir. 1999]. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)).<sup>24</sup>

Here, it is believed the Examiner has impermissibly used Appellant's claimed towel as a road map in order to combine the disparate features of Stark '818, Parker et al. '459 and Sherrill et al. '273 in an attempt to arrive at the subject matter of Claim 21.

*Issue 1. Conclusion (37 C.F.R. § 41.37(c)(1)(vii) subheading)*

The Examiner states what is well known in patent law that matters relating to ornamentation only which have no mechanical function, cannot be relied upon to patentably distinguish the claimed invention from the prior art. The Examiner concludes that "the design pattern created by the two yarns in the woven towel controls the way the fabric looks and does not effect the structure of the towel or the way the towel is used. The

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<sup>23</sup> *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.*, 75 F.3d 1568, 1573, 227 USPQ2d 657, 662 (Fed. Cir. 1996).

<sup>24</sup> *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317



towel is still made from multiple warp and weft yarns which are woven together to produce a standard terry cloth fabric, even if the yarns used to make the towel are all one color or all different colors. Hence, the pattern of the colored yarns only effects the ornamentation of the fabric and has no effect on the actual structure of the towel.”<sup>25</sup> This bald conclusion only demonstrates that the Examiner has not understood the structure that is behind these functional statements. As has been repeatedly stated, the dark colored border surrounding the light central area is capable of masking any printed pattern that might overlap onto the border from the central area.<sup>26</sup> This eliminates the need for precise alignment and monitoring that is mandatory in the preprinted filament process. Likewise, the dark central area on the reverse side of the article is capable of masking any potential bleed through of the printed design on the light colored central area of side one.<sup>27</sup>

Due to the shortcomings of each reference, it would appear that the Examiner has disregarded the Graham inquiries, and has instead relied on impermissible hindsight. The necessity of Graham findings is especially important where the invention is less technologically complex, as is the case here. In such a case, the danger increases that “the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.’”<sup>28</sup>

The towel of Claim 21 is not technically complex. It is easy to understand. However, it is still an invention that is undisclosed and unobvious from the prior art. As pointed out, the structure of the woven towel allow printed images to be applied more intensely than do other towels, while at the same time masking misalignment of the applied image within the central area.

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<sup>25</sup> U.S. Pat. App. No. 09/837,094 Non-Final Office Action dated 7/14/2005, Page 6, paragraph 2.

<sup>26</sup> U.S. Pat. App. No. 09/837,094 as filed, page 9, paragraphs 1.

<sup>27</sup> *Id.*, at Page 9, paragraph 2.

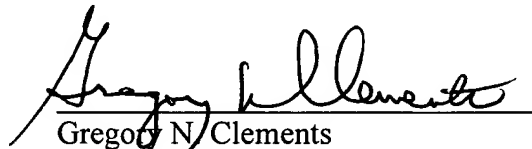
<sup>28</sup> See *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), abrogated on other grounds by *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000).

Attached Table 1 sets forth the elements of Claim 21 and views these with respect to the rejection of Stark, Parker, and Sherrill.

Issue 2 – The provisional rejection of claims 21, 22, and 24-27 under the judicially created doctrine of obviousness-type double patenting over the claims of copending Application No. 09/747,529.

This is a provisional rejection. As indicated to the Examiner, the Appellant is willing to file a terminal disclaimer upon indication of allowable subject matter in either this case, or the related case.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Gregory N. Clements", is written over a horizontal line.

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Attorney Docket 3129

**TABLE 1**

Claim 21	Stark v. Parker v. Sherrill
Weaving a towel on a Dobby loom using at least 2 different colors.	Stark does not disclose a specific weaving loom.
	Parker utilizes a Jacquard loom.
	Sherrill does not disclose a specific weaving loom.
Such that a border having a first darker color is woven adj. each edge on one side thereof.	Neither Stark nor Parker has this. Sherrill has a border defined by printing.
And a border having a second lighter color is woven adj. each edge of said towel on the other side.	Neither Stark nor Parker nor Sherrill has this.
Said towel having a central area woven within the borders on both sides.	There is a central area but no borders. Sherrill has a central area on only one side.
Said central area on other side is woven with 1 <sup>st</sup> color.	There is a central area but no borders.
Said central on said one side is woven in a 2 <sup>nd</sup> color.	There is a central area but no borders. Sherrill's border is same color as central area.
Forming a graphic impression in said central area on said one side.	Park discloses printing, but not within a central area. Sherrill discloses this.
Said border on said one side is capable of masking said graphic impression that may overlap onto said border from said central area on said one side.	Neither Stark nor Parker nor Sherrill has this.
Said central area on said second side is capable of masking any potential bleed through of said graphic impression from said central area of said one side.	Neither Stark nor Parker nor Sherrill has this.

*CLAIMS APPENDIX (37 C.F.R. § 41.37(c)(1)(viii)*

The claims on appeal appear as follows:

21. A towel having a graphic impression, produced by:

weaving a towel on a Dobby loom using at least two different colors of yarn, such that a border having a first darker color is woven adjacent each edge of said towel, on one side thereof, and a border having a second lighter color is woven adjacent of said towel on the other side, said towel having a central area woven within said borders on both said one side and said other side, said central area on said other side is woven with said first darker color, said central area on said one side is woven with said second lighter color,

shearing said one side to a height of about 75 to about 95% of the height of said other side;

blooming said one side such that a graphic impression can be intensely applied thereto;

forming a graphic impression in said central area on said one side, wherein said towel retains its preprinted water absorbency characteristics; and

wherein said border on said one side is capable of masking said graphic impression that may overlap onto said border from said central area on said one side, eliminating the need for precise alignment of said graphic impression within said central area of said one side; and wherein said central area on said second side is capable of masking any potential bleed through of said graphic impression from said central area of said one side.

22. The product of claim 21, wherein said forming is by screen printing, image dyeing, digital imaging, or heat transferring.

24. The product of claim 23, wherein said graphic impression has at least two different colors, neither being said first nor said second color.

25. The product of claim 23, wherein said border shape is selected from the class of rectangular shape, circular shape, oval shape, square shape, and irregular shape.

26. The product of claim 25, wherein said border is solid or a pattern.
27. The product of claim 26, wherein said pattern is selected from the class consisting of stripes, dots, names, silhouettes of sport players, animal shapes, corporate logos, or university mascots.

*EVIDENCE APPENDIX (37 C.F.R. § 41.37(c)(1)(ix))*

1. No additional evidence is presented beyond what is contained within the record.

*RELATED PROCEEDINGS APPENDIX (37 C.F.R. § 41.37(c)(1)(x))*

1. Attached hereto is a copy of the Board of Patent Appeals and Interferences' decision dated July 29, 2004 for the related Application Serial No. 09/747,529, reversing the Examiner's rejection.



The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

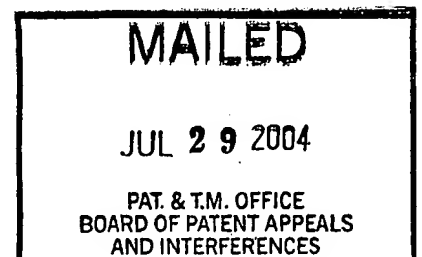
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte JAMES M. SHEPPARD, JR.

Appeal No. 2004-1029  
Application No. 09/747,529

HEARD: July 14, 2004



Before FRANKFORT, MCQUADE, and BAHR, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 21 through 36, all of the claims remaining in this application. Claims 1 through 20 have been canceled.

As noted on page 1 of the specification, appellant's invention relates to both a textile article and a method of making the textile article, wherein the textile article is a two-sided Jacquard woven textile product (e.g., a towel) with a



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graphic impression on at least one side thereof. The method of making the article as described in the specification comprises the steps of a) providing a two-sided Jacquard woven textile wherein the front side of the textile or towel has, for example, a dark color border adjacent each edge and a light color area within the borders, while the reverse side has a light color border adjacent each edge and a dark color area within and surrounded by the borders, and b) subsequently transferring a graphic impression onto the towel, preferably in the light color central area of the front side, by screen printing, image dyeing, digital imaging, or heat transferring. Independent claims 21 and 29 are representative of the subject matter on appeal and a copy of those claims can be found, respectively, in the Appendix to the examiner's answer and the Appendix to appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Hobson	4,259,994	Apr. 7, 1981
Carpenter et al. (Carpenter)	5,983,952	Nov. 16, 1999

Claims 21 through 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hobson in view of Carpenter.

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Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejection, we refer to the examiner's answer (mailed August 27, 2003) and to appellant's brief (filed June 25, 2003) and reply brief (filed October 6, 2003) for a full exposition thereof.

#### OPINION

Having carefully reviewed the obviousness issue raised in this appeal in light of the record before us, we have come to the conclusion that the examiner's rejection of claims 21 through 36 under 35 U.S.C. § 103 will not be sustained. Our reasoning in support of this determination follows.

After a careful evaluation of the teachings and suggestions to be derived by one of ordinary skill in the art from the patterned terry fabric and its method of manufacture on a tappet or dobby mechanism as described in Hobson, and the Jacquard weaving system and method set forth in Carpenter for ensuring automatic alignment of a printed pattern with a woven pattern on a textile fabric as that fabric is being formed, it is our opinion that the examiner has failed to meet her burden of

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establishing a *prima facie* case of obviousness. More particularly, we are of the view that the examiner's reasoning in support of the obviousness rejection before us on appeal (as expressed on pages 3-7 of the answer) is based almost entirely on speculation and conjecture, and with regard to the basic structure and color scheme of the towel defined in appellant's claim 21 and the textile of claim 29 on appeal, relies entirely upon appellant's own disclosure and teachings to supply that which is lacking in the applied prior art references.

Basically, we share appellant's views as aptly expressed in the brief and reply brief concerning the examiner's attempted combination of the Hobson and Carpenter patents, the failure of either Hobson or Carpenter to disclose borders adjacent each edge of a towel or textile product and a central area within and surrounded by the borders, which central area on one side of the towel or textile product receives a graphic impression, and the failure of either of the applied patents to teach or suggest the particular color arrangement of the borders and central areas required in the claims on appeal. We are also in agreement with appellant concerning the examiner's bald conclusion that "it would have been obvious to one of ordinary skill in the art to

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choose various printed designs, as well as choose where to place the printed image on the Hobson product . . ." (answer, pages 3-4), so as to result in a towel or textile like that claimed by appellant. Since neither the applied references nor the examiner provides an adequate factual basis to establish that the towel of claim 21 on appeal or the textile product of appellant's claim 29 would have been obvious to one of ordinary skill in the art at the time of appellant's invention, it follows that we will not sustain the examiner's rejection of those claims under 35 U.S.C. § 103(a).

In addition, we note that the examiner's rejection of claims 22 through 28 and 30 through 36 under 35 U.S.C. § 103(a) based on the combination of Hobson and Carpenter, which claims respectively depend from independent claims 21 and 29, will likewise not be sustained.

Since we have determined that the examiner has failed to establish a prima facie case of obviousness with regard to the claimed subject matter before us on appeal, we find it unnecessary to comment on appellant's evidence of secondary

